



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/681,391

03/28/2001

Stephen A. Byrne

85VF-00003

3266

23465 7590 11/02/2006

JOHN S. BEULICK  
C/O ARMSTRONG TEASDALE, LLP  
ONE METROPOLITAN SQUARE  
SUITE 2600  
ST LOUIS, MO 63102-2740

EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/681,391

Applicant(s)

BYRNE ET AL.

Examiner

Igor Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 13-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 08/21/2006 is acknowledged and entered. Claims 10-12, 44 and 45 have previously been canceled. Claims 1, 13, 15, 19, 21, 23, 29, 36 and 40 have been amended. Claims 1-9 and 13-43 are currently pending in the application.

Objection to Specification, Claim Rejections under 35 USC § 112 and Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 8, 9, 13-15, 18-25, 28-31, 34-36 are 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coons et al. (US 6,832,250) in view of Heinemann et al. (US 6,882,986).**

Coons et al. (Coons) teaches a method, system, and a computer-readable medium having computer-readable instructions embedded therein for implementing said method for remotely monitoring the usage of office equipment, said method including receiving data related to equipment usage at the remote location, processing said data, and generating a report regarding received data, comprising:

#### **Independent Claims**

Claims 1, 13, 19, 23, 29, 36 and 40,

inputting into the remote computer system meter data relating to equipment usage, said data including identification of the equipment (Fig. 5; C. 3, L. 2-15; C. 4, L. 15-17);

generating an export file by processing the meter data at the remote computer system, the export file including a plurality of data records (C. 3, L. 2-15; C. 4, L. 15-17);

applying business logic rules at the local computer system to control the functionality of the system (C. 7, L. 14-30);

generating reports concerning the usage data collected (C. 9, L. 9-11);

transmitting an invoice for payment by the customer for usage of the equipment (C. 9, L. 21-43).

Coons does not specifically teach that said applying business logic rules at the local computer system to control the functionality of the system includes *applying validation rules to the export file to determine the data records included within the export file that satisfy the validation rules*. Also, Coons does not specifically teach that generating reports concerning the usage data collected includes *generating an error report identifying the data records included within the export file that violate at least one of the validation rules including identifying data records that violate at least one of the validation rules due to at least one of a processing error at the local computer system and an inputting error at the remote computer system; generating a correction report corresponding to the error report; correcting each data record listed; and generating a corrected export file*.

Heinemann et al. (Heinemann) teaches a method, system, and a computer-readable medium having computer-readable instructions embedded therein for implementing said method for automatic processing of invoices, said system comprising a set of rules for validating the aggregated invoices, said validation is conducted to detect any errors contained in the invoices, to prepare an electronic file (reporting step) including data identifying said errors and data being indicative of measures taken to correct the error (C. 4, L. 34 – C. 5, L. 40; C. 10, L. 42-50; Figs. 8-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Coons to include that said applying business logic rules

Art Unit: 3628

at the local computer system to control the functionality of the system includes *applying validation rules to the export file to determine the data records included within the export file that satisfy the validation rules; generating an error report identifying the data records included within the export file that violate at least one of the validation rules; generating a correction report corresponding to the error report; correcting each data record listed; and generating a corrected export file*, as disclosed in Heinemann, because it would advantageously allow to automatically generate electronic billing for the services rendered and automatically compare the billing data with the rules data, as specifically stated in Heinemann.

Dependent Claims

Claim 2. Said method wherein the meter data is received in a predefined format (Coons; C. 8, L. 38-62).

Claims 3, 14, 18, 22, 28, 30, 34 and 39. Said method wherein said meter data includes information regarding invoicing (Coons; C. 8, L. 49-57).

Claim 4. Said method wherein the meter data is inputted into the remote computer system via the Internet (Coons; C. 4, L. 55-56).

Claims 5, 15, 20, 24 and 31. See reasoning applied to independent claims.

Claims 8, 21 and 25. See reasoning applied to independent claims.

Claim 9. See reasoning applied to Claim 8. The specific content of the report cannot change said method step, therefore is given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Claim 35. See reasoning applied to Claim 34. The specific content of the file transmitted does not indicate a structural element of the system, but rather an intended

use of the system, and, therefore, given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." Furthermore, the specification does not provide any indication of advantages of using the particular structure of the file. Without said indication the use of the particular file structure or software would be an obvious matter of the design choice.

Claims 41 and 43. See reasoning applied to claim 40.

Claims 6, 7, 16, 17, 26, 27, 32, 33, 37, 38 and 42. See reasoning applied to independent claims.

### ***Response to Arguments***

Applicant's arguments filed on 08/28/2006 have been fully considered but they are not persuasive.

In response to the applicant's argument that the prior art fails to disclose inputting into the remote computer meter data relating to computer usage wherein the meter data includes at least one of an amount of usage, equipment serial number, model number, meter reading date, and customer name, it is noted that Coons does, in fact, teach this feature. Specifically, Fig. 5 discloses customer account information, including a name of the customer, a type of equipment (a printer) and equipment serial number.

In response to the applicant's argument that the prior art fails to disclose generating at a local computer a correction report; and correcting each data record listed; and generating a corrected export file, it is noted that Heinemann was applied for this feature. Specifically, Heinemann discloses applying validating rules to the aggregated invoices to detect errors contained in the invoices, to prepare an electronic file including data identifying said errors and data being indicative of measures taken to correct the error (C. 4, L. 34 – C. 5, L. 40; C. 10, L. 42-50; Figs. 8-11).

In response to the applicant's argument that the prior art fails to disclose transmitting an invoice for payment by the customer for usage of said equipment, it is noted that Cools explicitly discloses that feature (See: C. 9, L. 21-43).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

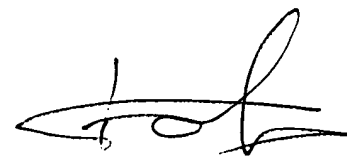
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3628

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

10/28/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a stylized, flowing script.

IGOR N. BORISSOV  
PRIMARY EXAMINER